

REMARKS

Applicants' attorney thanks the Examiner for his comments. Independent Claims 20 and 39 have been amended to recite a reactive diluent incorporated into the epoxy compound, the reactive diluent having at least one reactive terminal end portion. The epoxy compound and the reactive diluent having a weight ratio of 65:10 to 90:0.5. Claim 39 requires the reactive terminal and portion to include an epoxy group. Claim 1 has been further amended to recite that the adhesive composition passes the ICBO Heat Creep Test (ICBO Acceptance Criteria AC58) at 110°F and passes the ICBO Damp Hole Test at 75°F.

Claim 1 and Claim 39 were both amended to indicate the curing agent "comprising at least one aliphatic amine and at least one tertiary amine." The amendments are supported in Paragraphs 0009, 0027 and 0031-0034.

A. Claim Rejections Based on 35 U.S.C. §112

The rejection of Claims 44 and 45 under 35 U.S.C. §112, first paragraph, is respectfully traversed. The rejection of Claim 44 and 46 under 35 U.S.C. §112, second paragraph, is respectfully traversed. Claims 44-46 have been canceled, therefore rendering the rejections moot.

B. Claim Rejections Based On Obviousness – Type Double Patenting

The rejection of Claims 20-31 and 36-48 based on obviousness-type double patenting over Surjan et al. U.S. Patents 6,291,555 (Claims 1-19), 6,403,678 (Claims 1, 2 and 8-10) or 6,420,458 (Claims 1-12 and 23-26) in view of Coleman U.S. Patent 6,166,849 and Morgan U.S. Patent 5,681,128 is respectfully traversed.

The claims of the Surjan et al. patents disclose anchoring adhesives having very high viscosities. The claims of Surjan '555 describe an anchoring adhesive including a first part and a second part, each part having a viscosity of 5 million to 50 million centipoises. The claims of Surjan '678 describe a rope of chemical anchoring adhesive including first and second parts whose predominant components are fillers (naturally resulting in high viscosity), with Claim 19 describing the viscosities as 5 million to 50 million centipoise. The claims of Surjan '458 describe an anchoring adhesive including a first part and a second part whose predominant components are fillers (naturally resulting in high viscosity).

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Where the clear objectives were to provide anchoring adhesives having very high viscosity, which can be formed into a rope, and/or which are composed predominantly of fillers, it would have been counterintuitive to incorporate a reactive diluent. One clear purpose and result of a diluent is to improve liquid flow characteristics by lowering the viscosity. Such a purpose and result would have been contrary to the teachings of the Surjan et al. patent claims. The Surjan et al. patent claims do not suggest the use of a reactive diluent as claims by Applicant.

Coleman and Morgan also do not disclose the use of a reactive diluent as claimed, wherein the reactive diluent is incorporated into the epoxy compound and has at least one terminal end portion, and the epoxy compound and reactive diluent have a weight ratio of 65:10 to 90:0.5.

Moreover, terminal disclaimers are enclosed herewith to prevent a patent issuing from this application from extending beyond the expiration dates of the Surjan et al. patents. This rejection should be withdrawn.

The rejection of Claims 32-35 based on obviousness-type double patenting over the foregoing references, further in view of U.S. Patent 6,645,340 to Gienau and U.S. Patent 5,962,602 to Hartman, is respectfully traversed. While Gienau and Hartman disclose reactive diluents, they do so in the context of liquid, ultra-low viscosity adhesive compositions. These compositions are very different from the very high viscosity compositions described in the Surjan et al. patent claims. It would not have been obvious to modify the Surjan et al. patent claims to include reactive diluents used in liquid, ultra-low viscosity adhesive compositions. This rejection should be withdrawn.

C. Claim Rejections Based on 35 U.S.C. §103(a)

The rejection of Claims 20-31 and 36-48 under 35 U.S.C. §103(a) as obvious over Surjan et al. U.S. Patents 6,291,555; 6,403,678; 6,420,458; 6,402,434 and 6,416,256 in view of Coleman U.S. Patent 6,166,849 and Morgan U.S. Patent 5,681,128 is respectfully traversed. All of the Surjan et al. patents disclose very high viscosity

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two-part adhesive resin compositions whose parts have viscosities in the millions of centipoise. This is apparent from the following passages:

Surjan '555, Col. 2 lines 26-45 (viscosities of about 5 million to 50 million centipoise)

Surjan '678, Col. 2 lines 34-52 (viscosities of about 5 million to 50 million centipoise)

Surjan '458, Col. 2 lines 11-18 (solid, putty-like consistency)

Surjan '434, Col. 5 lines 8-23 (viscosities of about 5 million to 50 million centipoise)

Surjan '256, Col. 6 lines 64-Col. 7 line 19 (viscosities of about 5 million to 50 million centipoise)

Where the clear objectives of the Surjan et al. patents were to provide anchoring adhesives having very high viscosity, it would have been counterintuitive to incorporate ingredients such as diluents whose purpose and result is to lower the viscosity. Such a purpose and result would have been contrary to the teachings of the Surjan et al. patents. The Surjan et al. patents do not suggest the use of a reactive diluent as claimed by Applicant.

Moreover, the Surjan et al. patents are not available as prior art for purposes of a 35 U.S.C. §103(a) rejection. The instant patent application claims priority to U.S. Provisional Application 60/346,443, filed on December 28, 2001, and is based on International Application PCT/US02/41424, filed on December 27, 2002. The Surjan et al. patents have issue dates between September 18, 2001 and July 16, 2002, and would qualify as prior art only under 35 U.S. C. §102(e). At the time the claimed invention was made, the Surjan patents and the instant claimed invention were owned or subject to an obligation of assignment to the same entity, namely Illinois Tool Works Inc. The respective assignments to Illinois Tool Works Inc. have been recorded as follows:

	<u>Reel</u>	<u>Frame</u>
U.S. Patent Application 10/500,128	016403	0233
U.S. Patent 6,291,555	010793	0259
U.S. Patent 6,403,678	010964	0817
U.S. Patent 6,420,458	010973	0821
U.S. Patent 6,402,434	010973	0758
U.S. Patent 6,416,256	010973	0635

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Coleman and Morgan also do not disclose the use of a reactive diluent as claimed, wherein the reactive diluent is incorporated into the epoxy compound and has at least one terminal end portion, and the epoxy compound and reactive diluent have a weight ratio of 65:10 to 90:0.5. This rejection should be withdrawn.

The rejection of Claims 32-35 under 35 U.S.C. §103(a) as obvious over the foregoing references, further in view of U.S. Patent 6,645,340 to Gienau and U.S. Patent 5,962,602 to Hartman, is respectfully traversed. While Gienau and Hartman disclose reactive diluents, they do so in the context of ultra-low viscosity adhesive compositions. These compositions are very different from the very high viscosity compositions disclosed in the Surjan et al. patents. It would not have been obvious to modify the Surjan et al. patents to include reactive diluents used in liquid, ultra-low viscosity adhesive compositions. This rejection should be withdrawn.

The rejection of Claims 20-31 and 36-48 under 35 U.S.C. §103(a) as obvious over Coleman et al., Morgan et al., Gienau et al., Hartman et al., European Patent No. 488,949; CAPLUS accession no. 1985:596803 for the Toussaint et al. article, Grieves et al. Patent No. 4,623,702 and Japanese Patent No. 2000-273354, is respectfully traversed. This rejection did not apply to former Claim 32 or 33, whose limitations are now included in the independent claims. The rejection should be withdrawn.

D. Conclusion

Applicant believes that the claims, as now presented, are in condition for allowance. If the Examiner detects any unresolved issue, then Applicants' attorney respectfully requests a telephone call from the Examiner, and a telephone interview. The undersigned can be reached at (847) 490-1400.

Respectfully submitted,



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